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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,165	10/01/2004	Frank J Viola	2787 (203-3103)	6649

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Paul R Audet
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EXAMINER

WOO, JULIAN W

ART UNIT	PAPER NUMBER
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3731

MAIL DATE	DELIVERY MODE
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06/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/510,165

Applicant(s)

VIOLA, FRANK J

Examiner

Julian W. Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/29/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-7, 11, 13-20, 22, and 26-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Shannon (3,653,389). Shannon discloses, at least in the figures, a jaw blade (F) or an apparatus including a first leg (1) and a second leg (1), each leg having a jaw (at 6) integrally connected thereto, and extending distally therefrom, the jaws being configured to form a surgical clip disposed therebetween; and first and second inter-leg engaging members (8, 9) extending from one of the first and second legs, where when the interleg engaging member are engaged with the others of the first and second legs, a vertical displacement in a first direction of one of the first and second leg causes a first corresponding displacement in the first direction of the other of the first and second legs, and such that a vertical displacement in a second direction, opposite the first direction, of the one of the first and second legs causes a second corresponding displacement in the second direction of the other of the first and second legs, where the first and second interleg engaging members respectively comprise a first arm (8 or 9) having a tongue and a second arm (8 or 9) having a tongue, where the first and second legs each include an inner surface (at 7) and a recess (10) in an upper portion of the inner surface and engageable with a tongue, where the first arm closely

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overlies and is engageable the recess in the second leg and the second arm closely underlies and is engageable with the second leg, where a portion of the tongue of the first arm closely overlies the recess in a second upper surface of the second leg and a portion of the tongue of the second arm closely underlies the recess in a first lower surface of the first leg, where each of the first and second legs includes a neck (proximal of element 6) adjacent the jaw, where one inter-leg engaging member extends from neck of the first leg and another extends from the neck of the second leg, where the apparatus includes a handle portion (2 and/or 3 and/or 4) and a body portion (5).

3. Claims 1, 8, 12, 15, 17, 21, 26, 27, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Whitton, Jr. et al. (3,140,715). Whitton, Jr. et al. disclose a jaw blade including a first leg (11) and a second leg (12), each leg having a jaw (14, 15) integrally connected thereto, and extending distally therefrom, the jaws being configured to form a surgical clip disposed therebetween; and at least one inter-leg engaging members (20 or 22) extending from one of the first and second legs, where the first leg (12) includes a first arm (21) with a pair of transversely spaced apart tongues (22) where the second leg includes upper and lower surfaces (sides of 11) with respective upper and lower recesses (surfaces of 16) engageable with the tongues,

4. Claims 1, 3, 9, 10, and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Tartaglia (4,318,313). Tartaglia discloses, at least in figures 1-7, a jaw blade or apparatus including a first leg (10) and a second leg (10'), each leg having a jaw (14 or 14') integrally connected thereto, and extending distally therefrom, the jaws being configured to form a surgical clip disposed therebetween; and at least one or two

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inter-leg engaging members (30, 26, or 26 or 30', 26', or 26') extending from the first and second legs, where the jaw blade is assembled in a surgical clip applier (11); wherein when the jaws are in an open position, a portion of the inter-leg engaging member closely overlies and is slidably engageable with a portion of the other of the first and second legs, where the first leg and the second leg includes respective first and second neck portions (at 20 and 20'), where the apparatus includes a handle portion (12) and a body portion (16, 16'); and where an inter-leg member effects engagement with a first leg or second leg when the jaws are in an opened or closed position.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kortoff et al. (5,366,458) in view of Shannon (3,653,389). Kortoff et al. disclose the invention substantially as claimed. Kortoff et al. disclose, at least in figures 1-5 and in col. 5, line

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26 to col. 6, line 31; a method for applying surgical clips and performing blunt dissection of tissue, where the method includes providing a surgical clip applier ("a forceps-like instrument" with "jaws" or "forceps jaws") for applying surgical clips, performing a blunt dissection technique utilizing the jaws of the clip applier (i.e., by resiliently biasing the legs (of a clip) with the clip applier to displace tissue at a surgical site and "to allow application of the clip to the desired tissue site, e.g, by directing a pushing force against the rear face of block (31)," which brings the clip into engagement with tissue, and applying a surgical clip to a tissue or vascular target area (e.g., 40) utilizing the clip applier. However, Kortoff et al. do not disclose that the method includes a forceps-like instrument (i.e., a surgical clip applier) including first and second legs and at least one inter-leg engaging member extending between the legs and effecting an engagement between the first and second legs, such that vertical displacement in a first direction of one of the first and second legs causes a first corresponding displacement in the first direction of the other of the first and second legs, and such that a vertical displacement in a second direction, opposite the first direction, of one of the first and second legs causes a second corresponding displacement in the second direction of the other of the first and second legs. Shannon teaches, at least in the figures and in col. 1, lines 39-50, a forceps usable for the application of the clip of Kortoff et al., where the forceps includes first and second legs (1), jaws (at 6), and inter-leg engaging members (8, 9) as claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Shannon, to apply a forceps having first and second legs and inter-leg engaging members in the method of Kortoff et al. Such a forceps

would allow application of the clip of Kortoff et al. to a tissue, while allowing alignment of the jaws with respect to each other and preventing undue rocking motion of the jaws as the clip is manipulated with the forceps.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Caroli (3,646,801), Lahay (4,212,305), Tartaglia (4,452,106), Green (4,512,345), Porat et al. (5,019,091), and Lowe (5,156,431) teach jaw blades or apparatuses with legs, jaws, and inter-leg engaging members.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian W. Woo whose telephone number is (571) 272-4707. The examiner can normally be reached Mon.-Fri., 7:00 AM to 3:00 PM Eastern Time, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "Julian W. Woo". The signature is written in a cursive, flowing style.

Julian W. Woo
Primary Examiner

May 27, 2007